



gfed

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of : Cywin, C. L. et al) Art Unit: 1614
U.S. Appln. No. : 10/785,222) Examiner:
Confirmation No. : 1524
U.S. Filing Date : 02/24/2004
Title of Invention : GLUCOCORTICOID MIMETICS, METHODS OF MAKING THEM,
PHARMACEUTICAL COMPOSITIONS, AND USES THEREOF
Attny. Docket No. : 9/273

Mail Stop Amendment
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

October 8, 2004

TRANSMITTAL LETTER FOR SUPPLEMENTAL
INFORMATION DISCLOSURE STATEMENT

Sir:

Transmitted herewith concerning the subject application is an Information Disclosure Statement (Form 1449A and B) with copies of all references cited therein. This is being submitted pursuant to 37 C.F.R. §1.56 and before the mailing of a first Office Action on the merits, pursuant to 37 CFR § 1.97(b).

☒ 1.97(b). This Statement is being filed: i) within three (3) months of the filing date of a national application other than a continued prosecution application under 33 C.F.R. §1.53 (d); ii) within three (3) months of the date of entry of the national stage as set forth in 37 C.F.R. §1.491 in an international application; iii) before the mailing of a first Office action on the merits; or iv) before the mailing of a first Office action after the filing of a request for continued examination under 37 C.F.R. §1.114.

☐ 1.97(c). This Statement is being filed after the time period specified in 37 C.F.R. §1.97(b), but before the mailing date of: i) a final action under 37 C.F.R. §1.113, ii) a notice of allowance under 37 C.F.R. §1.311, or iii) an action that otherwise closes prosecution in the application. This Statement is being accompanied by:

☐ A statement as specified in 37 C.F.R. §1.97(e) [see below]; or

☐ The fee set forth in 37 C.F.R. §1.17(p).

☐ The Commissioner is hereby authorized to charge payment of the \$180.00 fee set forth in 37 C.F.R. §1.17(p) to Deposit Account No. 02-2955.

☐ 1.97(d). This Statement is being filed after the period specified in 37 C.F.R. §1.97(c) but on or before payment of the issue fee. This Statement is accompanied by a statement as specified in 37 C.F.R. §1.97(e) [see below] and the fee set forth in 37 C.F.R. §1.17(p).

☐ 1.97(e).

☐ Each item of information contained in the instant information disclosure statement was first cited in any communication from a foreign patent office in a counterpart foreign application not more than three (3) months prior to the filing of the instant information disclosure statement; or

☐ No item of information contained in the instant information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application, and, to the knowledge of the person signing this certification after making reasonable inquiry, no item of information contained in the instant information disclosure statement was known to any individual designated in 37 C.F.R. §1.56(c) more than three (3) months prior to the filing of the instant information disclosure statement.

☐ The fee set forth in 37 C.F.R. §1.17(p).

☐ The Commissioner is hereby authorized to charge payment of the \$180.00 fee set forth in 37 C.F.R. §1.17(p) to Deposit Account No. 02-2955.

☐ 1.704(d). Each item of information contained in the accompanying information disclosure statement was cited in a communication from a foreign patent office in a counterpart application, which communication was not received by any individual designated in section 1.56(c) more than thirty (30) days prior to the filing of the accompanying information disclosure statement.

☒ The Commissioner is hereby authorized to charge payment of any additional filing fees required under 37 C.F.R. §1.16 and any patent application processing fees under 37 C.F.R. §1.17, or credit any overpayment of same, to Deposit Account No. 02-2955.

Triplicate copies of this form are enclosed.

Respectfully submitted,



Philip I. Datlow
Attorney for Applicant(s)
Reg. No. 41,482

Patent Department
Boehringer Ingelheim Corp.
900 Ridgebury Road, P.O. Box 368
Ridgefield, CT 06877
Tel: (203) 798-4542

Certificate of Mailing

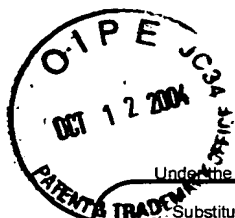
I hereby certify that this correspondence is being deposited with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to:

Mail Stop Amendment
Commissioner For Patents
P. O. Box 1450
Alexandria, VA 22313-1450

on October 8, 2004



Philip I. Datlow, Reg. No. 41,482



PTO/SB/08a (06-03)

Approved for use through 07/31/2003. OMB 0651-0031

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995 no persons are required to respond to a collection of information unless it contains a valid OMB control number.

Substitute for form 1449A/PTO

**INFORMATION DISCLOSURE
STATEMENT BY APPLICANT**

(Use as many sheets as necessary)

Sheet 1 of 5

Complete if Known

Application Number	10/785,222
Filing Date	February 24, 2004
First Named Inventor	CYWIN, Charles L., et al
Art Unit	1614
Examiner Name	To be assigned
Attorney Docket Number	9/273

U. S. PATENT DOCUMENTS

Examiner Initials*	Cite No. ¹	Document Number Number-Kind Code ² (if known)	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear
		US- 6,323,199	11/27/2001	Lehmann, M. et al	
		US- 5,039,691	08/13/1999	Spagnuolo, C. et al	
		US- 6,583,180	06/24/2003	Link, J.T. et al	
		US- 6,329,534	12/11/2001	Kym, P.R. et al	
		US- 6,436,986	08/20/2003	Kym, P.R. et al	
		US- 4,880,839	11/14/1999	Tucker, H.	
		US- 2002/0156311	10/24/2002	Link, J.T. et al	
		US- 6,506,766	01/14/2003	Coghlan, M.J. et al	
		US- 6,380,223	04/30/2002	Dow, R.L., et al	
		US- 2003/0232823 A1	12/18/2003	Betageri, R., et al	
		US- 2004/0097574 A1	05/20/2004	Marshall, D.R.	
		US- 2004/0010148 A1	01/15/2004	Kirrane, T.M., Jr. et al	
		US- 2004/0010020 A1	01/15/2004	Kirrane, T.M., Jr., et al	
		US- 2004/0029932 A1	02/12/2004	Bekkali, Y., et al	
		US- 2002/0077356 A1	06/20/2002	Jaroch, S., et al	
		US- 5,688,810	11/18/1997	Jones, Todd K.	
		US-			
		US-			

FOREIGN PATENT DOCUMENTS

Examiner Initials*	Cite No. ¹	Foreign Patent Document Country Code ³ Number ⁴ Kind Code ⁵ (if known)	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear	T ⁶
		WO 02/10143	02/07/2002	Schering Aktiengesel.		
		WO 02064550	08/22/2002	Abbott Laboratories		
		WO 99/41256	02/12/1999	Abbott Laboratories		
		WO 02/02565	01/10/2002	Abbott Laboratories		
		WO 00/66522	11/09/2000	Pfizer Products, Inc		

Examiner
SignatureDate
Considered

*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant. 1 Applicant's unique citation designation number (optional). 2 See Kinds Codes of USPTO Patent Documents at www.uspto.gov or MPEP 901.04. 3 Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). 4 For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. 5 Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST.16 if possible. 6 Applicant is to place a check mark here if English language Translation is attached.

This collection of information is required by 37 CFR 1.97 and 1.98. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

<p>Substitute for form 1449A/PTO</p> <p>INFORMATION DISCLOSURE STATEMENT BY APPLICANT</p> <p><i>(Use as many sheets as necessary)</i></p>				Complete if Known	
				Application Number	10/785,222
				Filing Date	February 24, 2004
				First Named Inventor	CYWIN, Charles L., et al
				Art Unit	1614
				Examiner Name	To be assigned
				Attorney Docket Number	9/273
Sheet	2	of	5		

U. S. PATENT DOCUMENTS

[illegible]

FOREIGN PATENT DOCUMENTS

Examiner Initials*	Cite No. ¹	Foreign Patent Document	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear	T ⁶
		Country Code ³ Number ⁴ Kind Code ⁵ (if known)				
		EP 0 253 500	02/27/1991	Imperial Chemical Ind		
		EP 0 253 503	12/11/1991	Imperial Chemical Ind		
		GB 2 146 987 A	09/19/1984	Sandoz, Ltd.		
		EP 0 154 528 A2	03/01/1985	Imperial Chemical Ind		
		EP 0311447	12/04/1989	Farmos Yhtymä Oy		

Examiner Signature		Date Considered	
-----------------------	--	--------------------	--

*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant. 1 Applicant's unique citation designation number (optional). 2 See Kinds codes of USPTO Patent Documents at www.uspto.gov or MPEP 901.04. 3 Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). 4 For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. 5 Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST.16 if possible. 6 Applicant is to place a check mark here if English language Translation is attached.

This collection of information is required by 37 CFR 1.97 and 1.98. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

Substitute for form 1449A/PTO

INFORMATION DISCLOSURE STATEMENT BY APPLICANT

(Use as many sheets as necessary)

Sheet 3 of 5

Complete if Known

Application Number	10/785,222
Filing Date	February 24, 2004
First Named Inventor	CYWIN, Charles
Art Unit	1614
Examiner Name	To be assigned
Attorney Docket Number	9/273

U. S. PATENT DOCUMENTS

Examiner Initials*	Cite No. ¹	Document Number	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear
		Number-Kind Code ² (if known)			
		US-			
		US-			
		US-			
		US-			
		US-			
		US-			
		US-			
		US-			
		US-			
		US-			
		US-			
		US-			
		US-			
		US-			
		US-			
		US-			
		US-			
		US-			
		US-			
		US-			
		US-			

FOREIGN PATENT DOCUMENTS

Examiner Initials*	Cite No. ¹	Foreign Patent Document	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear	T ⁶
		Country Code ³ Number ⁴ Kind Code ⁵ (if known)				
		WO 96/19458	06/27/1996	Ligand Pharmaceut.		
		WO 97/27852	08/07/1997	Merck & Company		
		WO 98/54159	12/03/1998	Schering Aktien.		
		WO 00/32584	06/08/2000	Schering Aktien.		
		BE 900594	09/17/1984	Sandoz S.A.		

Examiner
Signature

Date
Considered

*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant. ¹ Applicant's unique citation designation number (optional). ² See Kinds Codes of USPTO Patent Documents at www.uspto.gov or MPEP 901.04. ³ Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). ⁴ For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. ⁵ Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST. 16 if possible. ⁶ Applicant is to place a check mark here if English language Translation is attached.

This collection of information is required by 37 CFR 1.97 and 1.98. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

Substitute for form 1449B/PTO

**INFORMATION DISCLOSURE
STATEMENT BY APPLICANT**

(Use as many sheets as necessary)

Sheet

4

of

5

Complete if Known

Application Number

10/785,222

Filing Date

February 24, 2004

First Named Inventor

CYWIN, Charles L., et al

Art Unit

1614

Examiner Name

To be assigned

Attorney Docket Number

9/273

NON PATENT LITERATURE DOCUMENTS

Examiner Initials*	Cite No. ¹	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.	T ²
		Hamann, Lawrence, et al ; Discovery of a potent, Orally active, Nonsteroidal Androgen Receptor Agonist: 4-Ethyl-1,2,3,4-tetrahydro-6-(trifluoromethyl)-8-pyridono[5,6-gl-quinoline(LG121071), J. Med Chem, 1999, 42, 210-212	
		Pooley, Charlotte, et al; Discovery and Preliminary SAR Studies of a Novel Nonsteroidal Progesterone Receptor Antagonist Pharmacophore, J. Med. Chem 1998, 41, 3461-3466	
		Edwards, James, P. et al; 5-Aryl-1,2-dihydro-5H-chromeno[3,4-f]quinolines as Potent, Orally Active, Nonsteroidal Progesterone Receptor Agonists; The Effect of D-Ring Substituents, J. Med. Chem 1998, 41, 303-310.	
		Zhi, Lin, et al; 5-Aryl-1,2-dihydro-5H-chromeno[3,4-f]quinolines: A Novel Class of Nonsteroidal Human Progesterone Receptor Agonists, J. Med. Chem 1998, 41, 291-302	
		Zhi, Lin; et al 5-Aryl-1,2,3,4-tetrahydrochromeno[3,4-f]quinolin-3-ones as a Novel Class Of Nonsteroidal Progesterone Receptor Agonists: Effect of A-Ring Modification, J. Med. Chem 1999, 42, 1466-1472	
		Tegley, Christopher, et al; 5-Benzylidene 1,2-Dihydrochromeno[3,4-f]quinolines, A Novel Class of Nonsteroidal Human Progesterone Receptor Agonists; J. Med. Chem 1998, 41, 4354-4359	
		Edwards, James, P. et al; Preparation, Resolution and Biological Evaluation of 5-Aryl-1,2-dihydro-5H-chromeno[3,4-f]quinolines as Potent, Orally Active, Nonsteroidal Progesterone Receptor Agonists; J. Med. Chem, 1998, 41, 2779-2785.	
		Hamann, Lawrence, et al; Synthesis and Biological Activity of a Novel Series of Nonsteroidal, Peripherally Selective androgen Receptor Antagonists Derived from 1,2-Dihydropyridono[5,6-g] quinolines. J. Med. Chem. 1998, 41, 623-639	
		English Translation of WO/02/10143	

Examiner
SignatureDate
Considered

*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

¹ Applicant's unique citation designation number (optional). ² Applicant is to place a check mark here if English language Translation is attached.

This collection of information is required by 37 CFR 1.97 and 1.98. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

Substitute for form 1449B/PTO INFORMATION DISCLOSURE STATEMENT BY APPLICANT <i>(Use as many sheets as necessary)</i>				Complete if Known	
				Application Number	10/785,222
				Filing Date	February 24, 2004
				First Named Inventor	CYWIN, Charles L., et al
				Art Unit	1614
				Examiner Name	To be assigned
				Attorney Docket Number	9/273
Sheet	5	of	5		

[illegible]

Examiner Signature		Date Considered	
-----------------------	--	--------------------	--

*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

1 Applicant's unique citation designation number (optional). 2 Applicant is to place a check mark here if English language Translation is attached

This collection of information is required by 37 CFR 1.97 and 1.98. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.